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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/029,650	12/20/2001	Gregory T. Newman	45,024	5097

28309 7590 11/06/2002

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EXAMINER

COHEN, AMY R

ART UNIT	PAPER NUMBER
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2859

DATE MAILED: 11/06/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/029,650

Applicant(s)

NEWMAN, GREGORY T.

Examiner

Amy R Cohen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-3 and 5-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Miller (U. S. Patent No. 6,421,928).

Miller teaches a leveling and marking tool (10) for mounting items (70) having precut mounting holes to a wall, for making indenting marks in the wall that are in spaced apart relationship to match the precut mounting holes of the item to be mounted, the leveling and marking tool comprising: a frame (12) having a front surface, a back surface, a lengthwise opening (26), a first projected tab (32) mounted at an end of the frame on the same axis as the lengthwise opening, a second projected tab (34) movable in an axial direction along the lengthwise opening, threadable locking means for fixing the second projected tab in selected locations along the lengthwise opening spaced longitudinally from the first projected tab at a distance corresponding to the distance between the precut mounting holes (Col 5, lines 51-63),

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the first and second projected tabs each having a conical point that outwardly projects from the back surface of the frame (36, 37), at least one bubble gauge (22) mounted to the frame, and means associated with the first projected tab and the second projected tab for accurately indenting said marks in the wall (18,20).

Miller teaches the tool wherein the conical point of the first projected tab and the conical point of the second projected tab outwardly project an equal distance from the back surface of the frame (Col 6, lines 18-49).

Miller teaches the tool wherein the means for indenting the marks in the wall is performed by placing the back surface of the frame against the wall with the conical points of the first projected tab and the second projected tab in slight contact with the wall, aligning the frame against the wall, and firmly pressing the frame against the wall so that the said conical points firmly impact the wall (Col 7, lines 45-51).

Miller teaches a leveling and marking tool (10) for mounting an item having precut mounting holes to a wall, and for making marks on the wall that are in spaced apart relationship to match the precut holes of the item to be mounted, the tool comprising: a frame (12) having an axis (17), a first projected tab (32) mounted at an end of the frame on the axis, a second projected tab (34) movable in an axial direction along the frame, locking means (48) for fixing the second tab in selected locations along the frame spaced from the first projected tab at a distance corresponding to a distance between the precut mounting holes (Fig. 4), a leveling gauge (22, 24) on said frame and means (36, 37) associated with the first and second projecting tabs for making said marks in a spaced and level relationship on said wall such that the mounting holes for said item can be installed at said marks.

Miller teaches the marking and leveling tool wherein the first and second projected tabs each include a conical point (36, 37) such that said marks are indented into the wall by applying pressure (Col 7, lines 45-51).

Miller teaches the marking and leveling tool wherein the leveling gauge (22, 24) is a bubble gauge mounted in the frame of the tool (Fig. 1).

Miller teaches the marking and leveling tool wherein the locking means includes threads and passes through a longitudinal slot in the frame (Col 5, lines 51-63).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miller.

Miller discloses the tool as described above in paragraph 2.

Miller does not disclose a tool wherein the conical point of the first projected tab and the conical point of the second projected tab are 45 degrees coned shaped points.

Regarding the specific angle of the coned shaped points: Miller discloses a coned shaped point (36, 37) where the degree of the coned shaped points is not specifically stated. However, to choose a 45 degree coned shaped point of the conical points, absent any criticality, is only considered to be the "optimum" value of the coned shaped points, as stated above, that a person having ordinary skill in the art would have been able to determine using routine experimentation based, among other things, on the desired accuracy and since it has been held that discovering an

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optimum value of a result effective variable involves only routine skill in the art. See *In re Boesch*, 205 USPQ 215 (CCPA 1980).

Conclusion


5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following patents disclose leveling and marking devices Miodragovic (U. S. Patent No. 6,029,362), Tolley (U. S. Patent No. 4,944,096), and Brandimarte (U. S. Patent No. 4,648,185).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy R Cohen whose telephone number is (703) 305-4972. The examiner can normally be reached on 8 am - 5 pm, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego Gutierrez can be reached on (703) 308-3875. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-3431.

ARC
October 31, 2002


Diego Gutierrez
Supervisory Examiner
Tech Center 2800